



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : Kristin Carman
Serial No. : 09/750,028
Filed : December 29, 2000
Title : COMPACT DISK CASE

Art Unit : 3622
Examiner : Yehdega Retta
Confirmation No.: 6435

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

(1) Real Party in Interest

America Online, Inc., the assignee of this application, is the real party in interest.

(2) Related Appeals and Interferences

There are no related appeals or interferences.

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(3) Status of Claims

Claims 1-49 are pending in this application, of which claims 1 and 29 are independent.
All claims have been rejected, and all claims have been appealed.

(4) Status of Amendments

The claims have not been amended subsequent to the final rejection.

(5) Summary of Claimed Subject Matter

Each of the independent claims is directed to a compact disk case that includes, *inter alia*, a first side and a second side connected to the first side so as to permit the first side to move relative to the second side between a closed position and an open position. The first side is structured and arranged to define a viewing window that constitutes less than all of the first side to provide a first viewing characteristic that differs from a second viewing characteristic that is provided through another portion of the first side. See e.g., Specification at page 1, lines 18-22; page 4, lines 13-14; page 4, lines 36-29; and FIG. 1 (showing a compact disk case having a viewing window). The viewing window exposes a portion that is less than all of the surface of a

disk inserted into the compact disk case. See e.g., FIG. 1 (showing a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case). The portion that is less than all of the surface of the disk inserted into the compact disk case is viewable through the viewing window. See e.g., FIG. 1 (showing a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case).

Independent claim 1 recites the features in the context of the compact disk case. See e.g., Specification at page 1, lines 18-22. Independent claim 29 recites the features in the context of a method of distributing marketing materials stored as data on compact disk in a case. See e.g., Specification at FIG. 4 (depicting a method for distributing marketing materials) and page 6, line 20 to page 7, line 18 (describing a process depicted in FIG. 4).

(6) Grounds of Rejection

a. Claims 1-49

Claims 1-49 were rejected under 35 U.S.C. § 102 as being anticipated by AOL's CD package as indicated in the article AOL Virtual Museum, www.brainblips.com/aol/aol5.0.html and AOL Virtual Museum, www.brainblips.com/aol/aol_canada.html (hereinafter AOL).

b. Claims 1-23 and 29-44

Claims 1-23 and 29-44 also were rejected under 35 U.S.C. § 103 as being unpatentable over Flores (U.S. Patent No. 6,454,090) in further view of the AOL reference.

c. Requirement for Information under 37 C.F.R. § 1.105

The Office action of December 7, 2004 required submission of information under 37 C.F.R. § 1.105 and noted, *inter alia*, particular interest in "information related to the field of endeavor or business practices used by appellant's professional business ventures [and] where the claimed invention is an improvement, identification of what is being improved and identification of any use of the claimed invention known to any of the inventors at the time the application was filed." See Office action mailed December 7, 2004 at page 3, line 18 to page 4, line 1. See e.g., Office action mailed December 7, 2004 at pages 2-4.

(7) Argument

a. The subject matter of claims 1-49 is not anticipated by the AOL reference.

Claims 1-28

Appellant requests reversal of this rejection because the AOL reference is not statutory prior art under § 102 for any of the claims in the present application.

The application was filed on December 29, 2000 and claimed the benefit of Provisional Application No. 60/236,350 that was filed on September 29, 2000. The Notice of References cited provided with the Office action of December 7, 2004 did not include a date for either AOL Virtual Museum, www.brainblips.com/aol/aol5.0html and AOL Virtual Museum, www.brainblips.com/aol/aol_canada.html. The AOL reference indicates a date of "12/20/01" on page 1 of 2 of www.brainblips.com/aol/aol_canada.html and a date of "12/19/2001" on page 1 of 4 of www.brainblips.com/aol/aol5.0html. Thus, since the AOL reference was published after the filing date of the present application, it cannot constitute anticipatory prior art.

Assuming for the sake of argument only that the AOL reference is statutory prior art under § 102 for any of the claims in the present application, appellant now responds to the subject matter of the § 102 rejection. The AOL reference appears to show America Online's packaging practices prior to the subject matter disclosed in the present application, as described below in appellant's response to the request for information. The images shown in the AOL reference appear to show a cardboard mailer (that presumably contained a compact disk), a compact disk shrink wrapped to a cardboard card, or a DVD box (that presumably contained a compact disk). However, and as such, none of the images included in the AOL reference disclose a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in the independent claims 1 and 29.

With regard to independent claim 1, a compact disk case is recited that includes, *inter alia*, a first side that is structured and arranged to define a viewing window that constitutes less than all of the first side to provide a first viewing characteristic that differs from a second viewing characteristic that is provided through another portion of the first side. The viewing

window exposes a portion that is less than all of the surface of a disk inserted into the compact disk case.

One aspect of the AOL reference appears to show some images of a cardboard mailer (that presumably contained a compact disk). However, this aspect of the AOL reference does not disclose a compact disk case, much less a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in the independent claim 1.

In another aspect, the AOL reference appears to show a compact disk that is shrink wrapped to a cardboard card. See the AOL Reference at page 1 of 4 to page 3 of 4 of www.brainblips.com/aol/aol5.0html. The AOL reference discloses adhering the compact disk to a cardboard card using transparent plastic wrap. However, this aspect of the AOL reference also fails to disclose a compact disk case, much less a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in the independent claim 1.

In yet another aspect, the AOL reference appears to disclose a DVD Box that did not have a window or labeled applications. Examples of the DVD box appear to be shown on page 4 of 4 of www.brainblips.com/aol/aol5.0html. However, this aspect of the AOL reference also fails to disclose a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in the independent claim 1.

For at least these reasons, appellant requests reversal of the rejection of independent claim 1 and claims 2-28, which depend directly or indirectly from claim 1.

Claims 29-49

Independent claim 29 recites a method of distributing marketing materials stored as data on compact disk in a case having substantially the same features as recited in claim 1.

Accordingly, for at least the reasons noted above with respect to claim 1, the rejection of independent claim 29 should be reversed. Appellant requests reversal of the rejection of claims 30-49 that depend on claim 29.

b. The subject matter of claims 1-23 and 29-44 would not have been obvious over Flores in view of the AOL reference

Claims 1-23

As discussed above with respect to the anticipation rejection of claim 1, the AOL reference is not prior art to the present application, and thus, the proposed combination does not constitute prior art under § 103. For this reason, the rejection should be reversed.

In addition, on the merits, Flores does not describe or suggest a compact disk having first side that includes a viewing window that constitutes less than all of the first side. More particularly, Flores describes a compact disk storage case where the entire first side “comprises a transparent window 116 such that either the cover or a front page of the pamphlet, brochure, booklet or the like may be viewed when the disc storage container is closed.” See Flores at col. 7, lines 8-13 and FIG. 6, element 116. As such, Flores does not describe or suggest a first side of the compact disk case that includes a viewing window that constitutes less than all of the first side. Because the viewing window of Flores constitutes the entire first side of the compact disk case, this viewing window only provides one viewing characteristic. See Flores at col. 7, lines 8-13 and FIG. 6, element 116. This is because Flores merely describes a first side of the case that “comprises a transparent window” through which “either the cover or a front page of [a] pamphlet, brochure, booklet or the like” may be viewed. See Flores at col. 7, lines 9-13 (emphasis added). Since Flores only contemplates viewing one item at a time (either the cover or the front page of a booklet) through a single viewing window, the viewing window does not provide a first viewing characteristic that differs from a second viewing characteristic. Accordingly Flores does not describe or suggest a viewing window that provides a first viewing characteristic that differs from a second viewing characteristic provided through another portion of the first side.

Moreover, Flores' disk storage case exposes for viewing all of the surface of the disk. Thus, Flores does not describe or suggest a compact disk case having a viewing window that exposes a portion that is less than all of a surface of a disk inserted into the compact disk case, as recited in independent claim 1.

For at least these reasons, the rejection of independent claim 1 and its dependent claims 2-23 should be reversed.

Claims 29-44

As noted previously, independent claim 29 recites a method of distributing marketing materials stored as data on compact disk in a case having substantially the same features as recited in claim 1.

Accordingly, for at least the reasons noted above with respect to the obviousness rejection of claim 1, the obviousness rejection of independent claim 29 should be reversed. Appellant requests reversal of the rejection of claims 30-49 that depend on claim 29.

c. Requirement for Information under 37 C.F.R. § 1.105

As noted in appellant's response to the final Office action of December 7, 2004, appellant understands the request for information to be a request for information about AOL's CD packaging practices relative to the claimed subject matter of the present application. Appellant filed a response on March 7, 2005, which was found to be incomplete in an Office action mailed April 12, 2005. Subsequently, appellant completed an internal investigation and filed, on June 6, 2005, a supplemental response including a declaration, as described more fully below. As of the filing date of this Appeal Brief, no further communication from the Office has been received.

Appellant's supplemental response filed on June 6, 2005 is summarized here.

Prior to the filing date of the present application, AOL mailed a compact disk case that included a viewing window that exposed a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in claim 1 of the present application. However, appellant's representative is not aware of any such mailings more than one year prior to the filing of the present application. Moreover, attempting to confirm their understanding that no such mailings had occurred more than one year prior to the filing date, appellant's representative performed an investigation contemporaneous with filing the present application. The results of that investigation did not reveal (1) any mailings of the claimed compact disk case or (2) any activities by AOL of the claimed subject matter more than one year prior to the filing date of the present application. As previously stated, information made known to appellant's representative during the investigation conducted contemporaneous with the application filing indicated that no activity constituting the claimed subject matter took place by AOL more than one year prior to the filing date of the present application.

A declaration of inventor Ms. Lisa Riofrio (formerly Lisa Whitmore) was provided with the supplemental response. The declaration indicated that Ms. Riofrio has no personal knowledge of mailing by AOL of the claimed compact disk case more than one year prior to the filing date of the present application.

In addition, appellant's representative attempted obtain a declaration from the first-named inventor Ms. Kristin Carman. Ms. Carman is no longer an employee of AOL, and appellant's representative was unable to contact Ms. Carman. More particularly, appellant's representative attempted to contact Ms. Carman, using Ms. Carman's e-mail message account, on at least five occasions between April 19, 2005 and May 10, 2005. No response was received from Ms. Carman to any of these attempts. In addition, AOL Legal department personnel could not locate Ms. Carman's current address or a working telephone number for Ms. Carman.

Appellant's representative asserts that appellant has provided the required information to the extent that appellant is able to readily do so. Appellant's representative, therefore, asserted, and continues to assert, that appellant's response constitutes a complete response to the requirement for information.

Appellant asserted, and continues to assert, that this information is the best information appellant can supply in to satisfy this request for information and, as such, constitutes a complete reply to the information request.

c. Conclusion

For the foregoing reasons, the rejections should be reversed.

In accordance with appellant's Notice of Appeal filed April 7, 2005, appellant submits this Appeal Brief.

Pursuant to 37 C.F.R. §1.136, applicant hereby petitions that the period for filing this Appeal Brief be extended for one month to and including July 7, 2005. The \$120 extension fee under 37 C.F.R. §1.17 is enclosed.

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A check in the amount of \$620 for the Appeal Brief filing fee (\$500) and the one-month extension fee (\$120) is enclosed. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: July 5, 2005



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Appendix of Claims

Claim 1. A compact disk case comprising:
a first side; and
a second side connected to the first side so as to permit the first side to move relative to the second side between a closed position and an open position;
wherein the first side is structured and arranged to define a viewing window, and
wherein:
the viewing window constitutes less than all of the first side to provide a first viewing characteristic that differs from a second viewing characteristic that is provided through another portion of the first side,
the viewing window exposes a portion that is less than all of a surface of a disk inserted into the compact disk case, and
the portion that is less than all of the surface of the disk inserted into the compact disk case is viewable through the viewing window.

Claim 2. The compact disk case of claim 1 wherein the viewing window comprises a hole in the first side.

Claim 3. The compact disk of claim 1 further comprising a transparent material provided to affect the first viewing characteristic.

Claim 4. The compact disk of claim 1 further comprising a translucent material provided to affect the first viewing characteristic.

Claim 5. The compact disk case of claim 1 wherein the viewing window comprises more than one viewing window defined by the first side.

Claim 6. The compact disk case of claim 1 further comprising a second viewing window defined by the second side.

Claim 7. The compact disk case of claim 2 wherein portions of the first side that are positioned around the viewing window are opaque.

Claim 8. The compact disk case of claim 1 wherein the viewing window is positioned in a lower half of the first side of the case.

Claim 9. The compact disk case of claim 1 wherein the viewing window has a rectangular shape.

Claim 10. The compact disk case of claim 1 wherein:
the first side and the second side form a closed cavity in the closed position; and
the viewing window enables perception of the closed cavity when the compact disk case is in the closed position.

Claim 11. The compact disk case of claim 1 wherein:
the first side and the second side form a closed cavity in the closed position; and
the compact disk case further comprises a disk securing member located within the closed cavity formed by the first side and the second side, a portion of the disk securing member extending away from the second side to engage a center hole portion of a compact disk.

Claim 12. The compact disk case of claim 11 wherein:
the first side and the second side include substantially flat opposing surfaces when in the closed position; and
the disk securing member is structured and arranged to separate a flat surface of the compact disk from the substantially flat surfaces of the first side and the second side.

Claim 13. The compact disk case of claim 11 further comprising an inner surface member upon which the disk securing member is positioned.

Claim 14. The compact disk case of claim 1 wherein the dimensions of the case are greater than the dimensions of a Jewel case typically used to store compact disks having a format that differs from a format of a digital versatile disk.

Claim 15. The compact disk case of claim 1 further comprising a compact disk within the case.

Claim 16. The compact disk case of claim 15 wherein the compact disk has a format that differs from a format of a digital versatile disk.

Claim 17. The compact disk case of claim 15 wherein the compact disk stores electronic marketing materials.

Claim 18. The compact disk case of claim 17 wherein the electronic marketing materials comprise computer software for installing an Internet service provider on a personal computer.

Claim 19. The compact disk case of claim 1 further comprising a disk protecting member positioned around a perimeter of the compact disk and extending away from the second side.

Claim 20. The compact disk case of claim 1 further comprising a securing mechanism capable of securing the first and second sides in the closed position during delivery of the compact disk case.

Claim 21. The compact disk case of claim 11 wherein the disk securing member includes a central portion that engages a compact disk.

Claim 22. The compact disk case of claim 1 further comprising a dual sided label that is affixed to the first side of the case and positioned over at least a portion of the viewing window.

Claim 23. The compact disk case of claim 22 wherein the label has information printed on both sides such that the information on a first side of the label is viewable while the case is in the closed position and the information on the second side of the label is viewable only while the case is in the open position.

Claim 24. The compact disk case of claim 23 wherein the first side of the label contains information identifying an intended recipient and the second side of the label contains marketing information relating the intended recipient to a marketing source.

Claim 25. The compact disk case of claim 24 further comprising a compact disk and postage affixed to the case wherein the compact disk is mailed to the intended recipient.

Claim 26. The compact disk case of claim 24 further comprising a compact disk, a wrapper around the case, and postage affixed to the wrapper.

Claim 27. The compact disk case of claim 25 wherein the compact disk is positioned within the case during mailing to the intended recipient.

Claim 28. The compact disk case of claim 26 wherein the compact disk is positioned outside the case during mailing to the intended recipient.

Claim 29. A method of distributing marketing materials, the method comprising:
obtaining a compact disk on which marketing materials are stored as data;
installing the compact disk in a case including a first side and a second side connected to the first side so as to permit the first side to move relative to the second side between a closed and an open position, wherein the first side is structured and arranged to define a viewing window and wherein:

the viewing window constitutes less than all of the first side to provide a first viewing characteristic that differs from a second viewing characteristic that is provided through another portion of the first side,

the viewing window exposes a portion that is less than all of a surface of a disk inserted into the compact disk case, and

the portion that is less than all of the surface of the disk inserted into the compact disk case is viewable through the viewing window; and
mailing the case containing the compact disk to an intended recipient.

Claim 30. The method of claim 29, wherein the viewing window comprises a hole in the first side such that installing the compact disk in the case includes installing the compact disk in a case including the hole in the first side.

Claim 31. The method of claim 29, wherein the case includes a transparent material provided to affect the first viewing characteristic such that installing the compact disk in the case includes installing the compact disk in a case including the transparent material provided to affect the first viewing characteristic.

Claim 32. The method of claim 29, wherein the case includes a translucent material provided to affect the first viewing characteristic such that installing the compact disk in the case includes installing the compact disk in a case including the translucent material provided to affect the first viewing characteristic.

Claim 33. The method of claim 29, wherein the viewing window comprises more than one viewing window defined by the first side such that installing the compact disk in the case includes installing the compact disk in a case including more than one viewing window defined by the first side.

Claim 34. The method of claim 29, wherein the case includes a second viewing window defined by the second side such that installing the compact disk in the case includes installing the compact disk in a case including a second viewing window defined by the second side.

Claim 35. The method of claim 29 wherein:

the first side and the second side form a closed cavity in the closed position; and
installing the compact disk in the case comprises securing the compact disk within the case using a disk securing member that is structured and arranged to separate a flat surface of the compact disk from substantially flat surfaces of the first side and the second side.

Claim 36. The method of claim 35 wherein the disk securing member includes a central portion that engages the compact disk when moved toward the second side such that the securing includes securing the compact disk in the case with the disk securing member by moving the central portion of the disk securing member toward the second side.

Claim 37. The method of claim 35 wherein the case includes a disk protecting member positioned within the case and around a perimeter of the compact disk, the disk protecting member extending away one of the first or the second side such that the securing includes securing the compact disk in the case with the compact disk protected by the disk protecting member.

Claim 38. The method of claim 35 wherein the case includes an inner surface member separate from the first side and the second side upon which the disk securing member is positioned such that the securing includes securing the compact disk with the disk securing member.

Claim 39. The method of claim 29 wherein the dimensions of the case are greater than the dimensions of a Jewel case typically used to store compact disks having a format that differs from a format of a digital versatile disk such that the installing comprises installing the compact disk in the case having dimensions greater than that of a Jewel case.

Claim 40. The method of claim 29 wherein the compact disk is a compact disk having a format that differs from a format for a digital versatile disk such that the obtaining comprises obtaining the compact disk having marketing materials stored in a format that differs from the format of the digital versatile disk format.

Claim 41. The method of claim 29 wherein the marketing materials on the compact disk comprise computer software for installing an Internet service provider on a personal computer such that the obtaining includes obtaining a compact disk with computer software for installing an Internet service provider.

Claim 42. The method of claim 29 wherein the case includes a securing mechanism capable of securing the first side and the second side during delivery of the compact disk such that the installing includes securing the first side relative to the second side by engaging the securing mechanism.

Claim 43. The method of claim 29 further comprising a dual sided label that is affixed to the first side of the case and positioned over at least a portion of the viewing window such that the mailing includes mailing the marketing materials with the dual sided label affixed to the case.

Claim 44. The method of claim 43 wherein the label has information printed both on the first side that is viewable while the case is in the closed position and the second side that is opposite the first side and that is viewable only while the case is in the open position such that the mailing includes mailing the marketing materials with the label with information viewable in the closed and open positions.

Claim 45. The method of claim 44 wherein the first side of the label contains information identifying an intended recipient and the second side of the label contains marketing information relating the intended recipient to a marketing source such that the mailing includes mailing the marketing materials with the identifying information viewable on the first side of the label and the marketing information viewable from the second side of the label.

Claim 46. The method of claim 45 further comprising postage affixed to the case wherein the compact disk case including the compact disk are mailed to the intended recipient such that the mailing includes mailing the marketing materials with postage affixed to the case.

Claim 47. The method of claim 45 further comprising a wrapper around the compact disk case and postage affixed to the wrapper such that the mailing includes mailing the compact disk case including the compact disk with the wrapper and postage affixed to the compact disk case.

Claim 48. The method of claim 46 wherein the compact disk is positioned within the case during mailing to the intended recipient such that the mailing includes mailing the marketing materials with the compact disk inside the compact disk case.

Claim 49. The method of claim 47 wherein the compact disk is positioned outside the compact disk case during mailing to the intended recipient such that the mailing includes mailing the marketing materials with the compact disk positioned outside the compact disk case.